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ATTORNEY DOCKET NO. 14014.0025US
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
King et al.)	Art Unit: 1643
)	
Application No. 07/110,791)	Examiner: Stephen L. Rawlings
)	
Filing Date: October 21, 1987)	Confirmation No. 7373
)	
For: HUMAN GENE RELATED TO BUT)	
DISTINCT FROM EGF RECEPTOR)	
GENE)	

PETITION UNDER 37 C.F.R. § 1.181 TO WITHDRAW HOLDING OF
ABANDONMENT

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

NEEDLE & ROSENBERG, P.C.
Customer Number 23859

Sir:

Pursuant to 37 C.F.R. § 1.181 and MPEP § 711.03(c)I, Applicants hereby petition for withdrawal of the holding of abandonment communicated in the Notice of Abandonment mailed March 21, 2006. Applicants submit that the present application is not in fact abandoned and the Notice of Abandonment was issued in error. The Notice of Abandonment indicates that the present application was abandoned in view of "[t]he decision by the Board of Patent Appeals and Interferences rendered on 11/21/2001 and because the period for seeking court review of the decision has expired and there are no allowed claims." This statement is incorrect because judgment was not entered against allowed claims 60 and 61, which claims were designated as not corresponding to the count in the interference and which claims remain pending and allowed in

342682

the present application. Because allowed claims remain pending in the present application, the present application is not in fact abandoned and the Notice of Abandonment was issued in error. Applicants respectfully request withdrawal of the holding of abandonment in the present application.

Statement of Facts

The present application was involved in Interference No. 104,519. At the time the interference was declared, claims 44, 46, 47, and 60-62 were pending and patentable (see Interference Initial Memorandum, attached as Exhibit A, and page 47 of Notice Declaring Interference, pages 1 and 45-52 attached as Exhibit B). Initially, all of the pending claims (claims 44, 46, 47, and 60-62) were designated as corresponding to the count in the interference (see page 47 of Exhibit B). After the Board of Patent Appeals and Interferences ("Board") entered its decision on preliminary motions, the interference was redeclared with a new count (see Order Redeclaring Interference, attached as Exhibit C). In the redeclaration, pending claims 60 and 61 were designated as not corresponding to the new count (see page 2 of Exhibit C). Subsequent to the redeclaration, the Board entered judgment against only those claims designated as corresponding to the count in the redeclared interference; that is, claims 44, 46, 47, and 62 (see page 2 of Judgment Pursuant To 37 C.F.R. § 1.662, attached as Exhibit D). No judgment was entered against pending claims 60 and 61.

A Notice of Abandonment was mailed March 21, 2006 in the present application. For the reasons, and based on the evidence, discussed above, Applicants submit that the present application is not in fact abandoned and the Notice of Abandonment was issued in error. The Notice of Abandonment indicates that the present application was abandoned in view of "[t]he

ATTORNEY DOCKET NO. 14014.0025US
Application No. 07/110,791

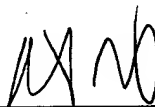
decision by the Board of Patent Appeals and Interferences rendered on 11/21/2001 and because the period for seeking court review of the decision has expired and there are no allowed claims." This statement is incorrect because judgment was not entered against allowed claims 60 and 61, which claims remain pending and allowed in the present application. Because allowed claims remain pending in the present application, the present application is not in fact abandoned and the Notice of Abandonment was issued in error. In view of these showings, applicant believes withdrawal of the holding of abandonment would be proper. Applicants respectfully request withdrawal of the holding of abandonment in the present application.

Favorable consideration of this Petition is earnestly solicited.

It is believed that no fee is due with this Petition because Applicants contend that the application is not abandoned (see MPEP § 711.03(c)I). In the event that it is determined that a fee is due, the Commissioner is hereby authorized to charge the fee to Deposit Account No. 14-0629.

Respectfully submitted,

NEEDLE & ROSENBERG, P.C.



Robert A. Hodges
Reg. No. 41,074

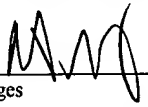
NEEDLE & ROSENBERG, P.C.
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)



ATTORNEY DOCKET NO. 14014.0025US
Application No. 07/110,791

CERTIFICATE OF MAILING UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence, including any items indicated as attached or included, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Petitions, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.



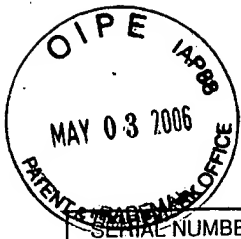
Robert A. Hodges

Date

5/1/2006

ATTORNEY DOCKET No. 14014.0025US
Application No. 07/110,791

EXHIBIT A



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/110,791	10/21/87	KING	14014.0025 DGP

18M2/0918
NEEDLE & ROSENBERG, P.C. SUITE 1200
THE CANDLER BUILDING
127 PEACHTREE STREET, N.E.
ATLANTA GEORGIA 30303

RECEIVED

SEP 23 1996

NEEDLE & ROSENBERG

MARSCO EXAMINER	
ART UNIT	PAPER NUMBER
1807	

DATE MAILED:

09/18/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

DOCKETED	
By: <u>CNB</u>	Date: <u>9-26-96</u>
Reviewed: <u>No dates to be docketed</u> <u>DGP</u>	
Name/Date	

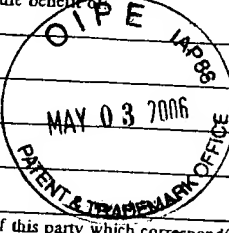
BOARD OF PATENT APPEALS

INTERFERENCE INITIAL MEMORANDUM

INTERFERENCES: An interference is found to exist between the following cases:

This interference involves _____ parties

PARTY KING ET AL	APPLICATION NO. 07/110,791	FILING DATE 10/21/87	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If application has been patented, have maintenance fees been paid? <input type="checkbox"/> Yes <input type="checkbox"/> No Maintenance fees not due yet				
COUNTRY US	APPLICATION NO. 06/836,414	FILING DATE 3/5/87	PATENT NO., IF ANY	ISSUE DATE, IF ANY
The claim(s) of this party which correspond(s) to this count is(are): PATENTED OR PATENTABLE PENDING CLAIMS 44, 46, 47, and 60-62				
UNPATENTABLE PENDING CLAIMS				
The claim(s) of this party which does(do) not correspond to this count is(are): PATENTED OR PATENTABLE PENDING CLAIMS				
UNPATENTABLE PENDING CLAIMS				



PARTY SLAMON ET AL	APPLICATION NO. 06/948265	FILING DATE 12/31/86	PATENT NO., IF ANY 4,968,603	ISSUE DATE, IF ANY 11/6/90
If application has been patented, have maintenance fees been paid? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No Maintenance fees not due yet				
COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
The claim(s) of this party which correspond(s) to this count is(are): PATENTED OR PATENTABLE PENDING CLAIMS 1-22				
UNPATENTABLE PENDING CLAIMS				
The claim(s) of this party which does(do) not correspond to this count is(are): PATENTED OR PATENTABLE PENDING CLAIMS				
UNPATENTABLE PENDING CLAIMS				

Instructions

- For every patent involved in the interference, check if the maintenance fees have been paid by using the patent number with PALM screen 2970. If fees are due and they have not been paid, the interference cannot be declared since it would involve an expired patent.
 - For each party, identify the patentable (or patented) and unpatentable (pending) claims which correspond to the count (37 CFR 1.601(f), (n); 1.609(b)(2)).
 - For each party, identify the patentable (or patented) and unpatentable (pending) claims which do not correspond to the count (37 CFR 1.609(b)(3)).
 - Forward all files including those the benefit of which is being accorded.
 - Keep a copy of the Interference Initial Memorandum and any attachments for your records.
- All information requested below must be attached on (a) separate typewritten sheet(s).
- On a separate sheet, set forth a single proposed interference count. If any claim of any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.
 - For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention as the count (37 CFR 1.609(b)(2)).
 - For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention from the count (37 CFR 1.609(b)(3)).
 - For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 CFR 1.609(b)(1)).

DATE 9/16/96	PRIMARY EXAMINER (Signature) Andi D. Mascher	TELEPHONE NO. (703) 308-3894	ART UNIT 1807
DATE	GROUP DIRECTOR SIGNATURE (if required)		

**The application number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

THIS PAGE CAN BE DUPLICATED IF THERE ARE MORE THAN TWO INTERFERING PARTIES.

Revised PTO-850 Interference Initial Memorandum appears on the reverse side of this sheet. This form has been revised to include the changes made to the interference rules as set forth in 1173 OG 49, particularly the changes to 37 C.F.R. § 1.609.

HIGHLIGHTS

1. Maintenance Fees

An interference is an extremely expensive and time consuming proceeding. When a patent is to be involved in an interference, such interference can only be set up with an *unexpired* patent. 35 U.S.C. § 135 and 37 C.F.R. §§ 1.602, 1.606, and 1.607. Since the examiner has the initial responsibility for reviewing the interfering applications and patents, it falls within the responsibility of the Examining Group to insure that the patent in question is in fact unexpired. This requires checking if the proper maintenance fees have been timely paid. Until this is done, the files should not be forwarded for declaration of an interference. The revised form includes instructions on how to verify whether Maintenance Fees for a U.S. Patent have been paid.

2. Explanation of why claims correspond to a count

Section 1.609(b)(2) of 37 C.F.R. requires an examiner's statement explaining why each claim designated as corresponding to a count is directed to the same patentable invention as the count. The purpose of the statement is to provide the Board and the parties involved in the interference with the benefit of the examiner's reasoning while deciding whether the interference should be declared and during consideration of preliminary motions. The reasoning set forth in 37 C.F.R. 1.601(n) must be followed consistent with Office practice for justifying rejections. This information must be typewritten on separate sheets of paper.

3. Explanation of why claims do not correspond to a count

Section 1.609(b)(3) of 37 C.F.R. requires an examiner's statement explaining why each claim designated as not corresponding to *any* count is not directed to the same patentable invention as *any* count. As above, this statement would provide the Board and the parties involved in the interference with the benefit of the examiner's reasoning during consideration of preliminary motions. The reasoning set forth in 37 C.F.R. 1.601(n) must be followed consistent with Office practice for justifying allowances. This information must be typewritten on separate sheets of paper.

4. Multiple Counts

In cases in which multiple counts are involved, 37 C.F.R. 1.609(b)(1) stipulates that the examiner must present reasons why each count is patentably distinct from the other counts. Once more, the reasoning set forth in 37 C.F.R. 1.601(n) must be followed consistent with Office practice for justifying allowances. If the examiner cannot justify the patentability of one count over another count, then they must be considered as directed to the same invention and, thus, only one count would be required for the inter partes proceedings. This information must be typewritten on separate sheets of paper.

If you have any questions concerning the new form or the rule changes, feel free to contact a Program and Resource Administrator at 703-308-9797.



Interference summary for 07/110,791 versus P/N 4,968,603.

Proposed phantom count: (combination of claim 44 of 07/110,791 and claim 1 of P/N 4,968,603)

A method of diagnosing or evaluating human cancer in a patient comprising: measuring the level of amplification in a tissue or tumor sample containing cells from said patient or increased expression of a MAC117 gene in a body sample from said patient, the presence of amplification or increased expression of said MAC117 gene indicating the presence of cancer or a cancer with a more malignant phenotype

OR

A method for screening patients to determine disease status, said method comprising: measuring the level of amplification or expression of the HER-2/neu gene in a sample from a patient suffering from breast or ovarian adenocarcinoma; and classifying those patients having an increased level of amplification or expression of the HER-2/neu gene relative to a reference level characteristic of normal cells as being more likely to suffer disease relapse or having a decreased chance of survival.

(Note that the Her-2/neu gene and the MAC117 gene are the same gene as summarized in P/N 4,968,603 in column 2, lines 39-43.)

All of the claims of 07/110,791 and P/N 4,968,603 correspond to the count in that they all are directed to evaluation, diagnosis, screening, or evaluation of cancer treatment as directly related procedures in that they are all based on the

analysis of the same gene regarding whether it is amplified, rearranged, or overexpressed in the tissue being tested. Such amplification, rearrangement, or overexpression being indicative of cancer diagnosis or when expressed regarding extent of gene alteration as indicative of a worsening condition of the patient whether being treated or not.

And H. Marschel
ANDIN H. MARSCHEL
PATENT EXAMINER
GROUP 1600

ATTORNEY DOCKET No. 14014.0025US
Application No. 07/110,791

EXHIBIT B

THIS DOCUMENT WAS NOT WRITTEN FOR PUBLICATION
and is not binding precedent of the Board

Paper 1

Filed by: Fred E. McKelvey, Senior
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

DENNIS J. SLAMON,
WILLIAM L. MCGUIRE, and AXEL ULLRICH

Junior Party
(Patent 4,968,603)

v.

C. RICHTER KING,
MATTHIAS H. KRAUS, and STUART A. AARONSON

Senior Party
(Application 07/110,791)

MAILED

APR 7 - 2000

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

Patent Interference No. 104,519

NOTICE DECLARING INTERFERENCE
(37 CFR § 1.611)

An interference is declared (35 U.S.C. § 135(a)) between the above-identified parties. Details of the application(s), patent (if any), reissue application (if any), count(s) and claims designated as corresponding or as not corresponding to the count(s) appear in an "Attachment" to this NOTICE DECLARING INTERFERENCE.

BEST AVAILABLE COPY



Attachment
(37 CFR § 1.611(c))

The parties involved in this interference are:

Junior Party

Named inventors: Dennis J. Slamon
Woodland Hills, California

William L. McGuire
San Antonio, Texas

Axel Ullrich
Rastatt, Germany

Application: 06/948,265,
filed 31 December 1986,
issued as 4,968,603
on 6 November 1990

Title: DETERMINATION OF STATUS IN
NEOPLASTIC DISEASE

Assignees: The Regents of the University of
California

Genentech, Inc.

The Board of Regents for the
University of Texas System

Attorneys: See last page

Accorded Benefit: None

Address: See last page

Senior Party

Named Inventors: C. Richter King
Washington, D.C.

Matthias H. Kraus
Bethesda, Maryland

Stuart A. Aaronson
Great Falls, Virginia

Application: 07/110,791, filed 21 October 1987

Title: HUMAN GENE RELATED TO BUT DISTINCT FROM EGF
RECEPTOR GENE

Assignee: The United States Government as Represented
by the Secretary of Health and Human
Services

Attorneys: See last page

Accorded Benefit: 06/836,414, filed 5 March 1986

Address: See last page

Count 1

A method according to claim 1, 7, or 17 of Slamon
(4,968,603)

or

A method according to claim 44, 60, 61, or 62 of King
(07/110,791).

The claims of the parties are:

Slamon:	1-22
King:	44, 46, 47, and 60-62

The claims of the parties which correspond to Count 1 are:

Slamon:	1-22
King:	44, 46, 47, and 60-62

The claims of the parties which do not correspond to Count 1
are:

Slamon:	none
King:	none

Appendix

Paper No. _____

Filed on behalf of: Party _____

By: Name of lead counsel
 Name of backup counsel
 Street address
 City, State, and ZIP Code
 Tel:
 Fax:

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS

AND INTERFERENCES

(Senior Administrative Patent Judge Fred E. McKelvey)

DENNIS J. SLAMON,
WILLIAM L. MCGUIRE, and AXEL ULLRICH

Junior Party
(Patent 4,968,603)

v.

C. RICHTER KING,
MATTHIAS H. KRAUS, and STUART A. AARONSON

Senior Party
(Application 07/110,791)

Patent Interference No. 104,519

TITLE OF PAPER

A. Summary of dates for taking action

Dates and times for taking action set in this NOTICE DECLARING INTERFERENCE are set out in **bold**. The following dates have been set in this NOTICE DECLARING INTERFERENCE:

1. **Paragraph 7:** date for identifying lead and backup counsel.
2. **Paragraph 8:** date for identifying any real party in interest.
3. **Paragraph 9:** date for requesting copies of involved and benefit applications and patents.
4. **Paragraph 17:** date and time for conference call.
5. **Paragraph 17:** date for filing list of preliminary motions to be filed.
6. **Paragraph 19:** date for accomplishing certain discovery.
7. **Paragraph 20:** date for filing clean copy of claims.
8. **Paragraph 21:** date for filing clean copy of claims in cases with drawings and/or claims containing a means plus function limitation.
9. **Paragraph 23:** dates for filing oppositions to Rule 635 motions and dates for filing replies to oppositions.
10. **Paragraph 33:** date for objecting to admissibility of evidence.
11. **Paragraph 34:** date for serving supplemental affidavits or evidence to respond to objection to admissibility of evidence.
12. **Paragraph 35:** date when cross-examination can take place.

13. Paragraph 45: dates for taking action with
respect to settlement discussions

cc (via Federal Express):

Counsel for Slamon
(real parties in interest, The Regents of the University of California, Genentech, and The Board of Regents for the University of Texas System):

(Counsel for The Regents of the University of California and Genentech):

James M. Heslin
Townsend and Townsend
Two Embarcadero Center
8th Floor
San Francisco, CA 94111

Tel: 415-576-0200
Fax: 415-576-0300

(Counsel for The Board of Regents for the University of Texas Systems):

David L. Parker
Howrey, Simon, Arnold, and White
750 Bering Dr.
Houston, Texas 77057

Tel: 713-787-1400
Fax: 713-787-1440

Counsel for King
(real party in interest, The United States of America as Represented by the Secretary of the Department of Health and Human Services):

Mr. William Needle
NEEDLE & ROSENBERG P.C.
Suite 1200, The Candler Building
127 Peachtree St., N.E.
Atlanta, GA 30303

Tel: 404-688-0770
Fax: 404-688-9880

Enc:

Copy of order used for setting times for taking action in the preliminary motion phase of the interference

Copy of order used for setting times for taking action in the testimony and briefing phases of the interference

PTO Form 850 and Rule 609(b) Statements

Copy of U.S. Patent 4,968,603

Copy of currently pending claims in 07/110,791

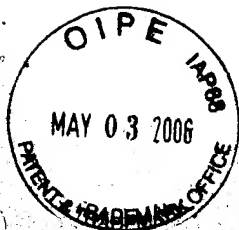
DECLARE.006.1

Revised October 1999

(replaces DECLARE.005 and DECLARE.006)

ATTORNEY DOCKET No. 14014.0025US
Application No. 07/110,791

EXHIBIT C



8/21

The opinion in support of the decision being entered today is not binding precedent of the Board.

Paper 100

Filed by: Sally Gardner-Lane
Administrative Patent Judge
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

14014.3122 US

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

C. RICHTER KING,
MATTHIAS H. KRAUS, and STUART A. AARONSON,

Junior Party
(Application 07/110,791)

v.

DENNIS J. SLAMON,
WILLIAM L. MCGUIRE, and AXEL ULLRICH,

Senior Party
(Patent 4,968,603)

Patent Interference No. 104,519

ORDER REDECLARING INTERFERENCE

(37 CFR § 1.611)

In view of the decision on preliminary motions (Paper 99) entered in the above identified interference, the interference will be redeclared.

RECEIVED

AUG 22 2001

NEEDLE & ROSENBERG

MAILED

AUG 21 2001

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

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It is

ORDERED that the interference is redeclared as follows:

1. Count 2¹, set forth below, is substituted for Count 1 (material deleted from count 1 is stricken out).

Count 2

A method according to claim 1, 7, or 17 of Slamon (4,968,603)

or

A method according to claim 44, ~~60, 61~~, or 62 of King (07/110,791).

2. The claims of the parties are:

Slamon: 1-22

King: 44, 46, 47, and 60-62

The claims of the parties which correspond to Count 2 are:

Slamon: 1-22

King: 44, 46, 47, and 62

The claims of the parties which do not correspond to Count 2 are:

Slamon: none

King: 60 and 61

¹ Count 2 is the same as proposed count A of Slamon preliminary motion 1 (Paper 31).


5. Slamon is accorded no benefit for the purpose of priority as to count 2.

6. King is accorded no benefit for the purpose of priority as to count 2.

FURTHER ORDERED that, to the extent applicable, the procedures set forth in the attached STANDING ORDER are in effect for the remainder of the interference;

FURTHER ORDERED that the caption of papers filed in the remainder of the interference shall be the caption on this ORDER;

FURTHER ORDERED that within 10 (ten) days of the date of this ORDER, each party shall either: (1) file a statement indicating that it is relying on the preliminary statement it has already filed in the interference for the subject matter of count 2 or (2) file a new preliminary statement for the subject matter of count 2;


Sally Gardner-Lane
Administrative Patent Judge

Date _____
Arlington, VA

Enc: Copy of STANDING ORDER

cc (via Federal Express):

Counsel for Slamon (real parties in interest:

1. The Regents of the University of California (licensee, Bayer Corp.)
2. The Regents for the University of Texas System (licensee, —
Ventana Medical Systems)
3. Genentech)

Steven B. Kelber
Piper, Marbury, Rudnick & Wolfe, LLP
1200 Nineteenth St., N.W.
Washington, D.C. 20036-2430

Tel: 202-861-3900
Fax: 202-223-2085
e-mail: steven.kelber@piperrudnick.com

Counsel for King (real party in interest, The United States of America as represented by the Secretary, Department of Health and Human Services)

William R. Johnson
Mary L. Miller
NEEDLE & ROSENBERG, P.C.
Suite 1200, The Candler Building
127 Peachtree St., N.E.
Atlanta, GA 30303

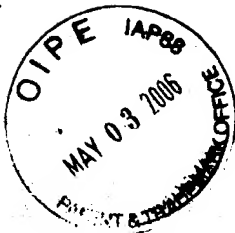
Tel: 404-688-0770
Fax: 404-688-9880
e-mail: johnston@needlepatent.com

Susan S. Rucker
Office of Technology Transfer
National Institutes of Health
6011 Executive Blvd., Ste. 325
Rockville, MD 20852-3804

Tel: 301-496-7056, ext. 245
Fax: 301-402-0220

ATTORNEY DOCKET No. 14014.0025US
Application No. 07/110,791

EXHIBIT D



This opinion is not binding precedent of the Board.

Filed by:

Trial Section Motions Panel
Box Interference
Washington, D.C. 20231
Tel: 703-308-9797
Fax: 703-305-0942

RECEIVED

NOV 27 2001

NEEDLE & ROSENBERG

Paper 106

14014.0025US
.3122

UNITED STATES PATENT AND TRADEMARK OFFICE

C. RICHTER KING,
MATTHIAS H. KRAUS, and STUART A. AARONSON,

Junior Party
(Application 07/110,791)

MAILED

NOV 21 2001

DENNIS J. SLAMON,
WILLIAM L. McGUIRE, and AXEL ULLRICH, AND INTERFERENCES

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS

Senior Party
(Patent 4,968,603)

Patent Interference No. 104,519

Before LEE, GARDNER-LANE, and TIERNEY, Administrative Patent Judges

GARDNER-LANE, Administrative Patent Judge.

WRJ
MLM
SJC
FILE COPY <input checked="" type="checkbox"/>

JUDGMENT PURSUANT TO 37 CFR § 1.662

King has filed a paper stating the following (Paper 105 at 2) :

In accordance with the provisions of 37 C.F.R. §1.662, King hereby abandons the contest as to the existing count.

BEST AVAILABLE COPY

WRJ/MLM/SGC

DOCKETED	
By <u>DM</u>	Date <u>11/27/01</u>
Reviewed _____	Name/Date _____

King's statement is treated as a request for entry of adverse judgment against King as to all its claims that correspond to the count. See 37 CFR § 1.662(a).

ORDER

Upon consideration of the record of the interference, it is

ORDERED that judgment on priority as to Count 2¹, the sole count in the interference, is awarded against junior party C. RICHTER KING, MATTHIAS H. KRAUS, and STUART A. AARONSON;

FURTHER ORDERED that junior party C. RICHTER KING, MATTHIAS H. KRAUS, and STUART A. AARONSON, is not entitled to a patent containing claims 44, 46, 47, and 62 of application 07/110,791, which correspond to Count 2;

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the King's 07/110,791 application and Slamon's 4,968,603 patent; and

¹ Count 2 and the claims of the parties which correspond to Count 2 are set forth at Paper 100 (Order Redeclaring Interference).



BOARD OF PATENT
APPEALS AND
INTERFERENCES



cc (via facsimile and first class mail):

Counsel for Slamon (real parties in interest:

1. The Regents of the University of California (licensee, Bayer Corp.)
2. The Regents for the University of Texas System (licensee, Ventana Medical Systems)
3. Genentech)

Steven B. Kelber
Piper, Marbury, Rudnick & Wolfe, LLP
1200 Nineteenth St., N.W.
Washington, D.C. 20036-2430

Tel: 202-861-3900
Fax: 202-223-2085
e-mail: steven.kelber@piperrudnick.com

Counsel for King (real party in interest, The United States of America as represented by the Secretary, Department of Health and Human Services)

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It is

ORDERED that the interference is redeclared as follows:

1. Count 2¹, set forth below, is substituted for Count 1 (material deleted from count 1 is stricken out).

Count 2

A method according to claim 1, 7, or 17 of Slamon (4,968,603)

or

A method according to claim 44, ~~60, 61~~, or 62 of King (07/110,791).

2. The claims of the parties are:

Slamon: 1-22

King: 44, 46, 47, and 60-62

The claims of the parties which correspond to Count 2 are:

Slamon: 1-22

King: 44, 46, 47, and 62

The claims of the parties which do not correspond to Count 2 are:

Slamon: none

King: 60 and 61

¹ Count 2 is the same as proposed count A of Slamon preliminary motion 1 (Paper 31).